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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,483	06/05/2001	Glenn M. Renwick	3832/010581	6164

7590

09/15/2005

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EXAMINER

FRENEL, VANEL

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/874,483

Applicant(s)

RENWICK ET AL.

Examiner

Vanel Frenel

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 01182002.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### Notice to Applicant

1. This communication is in response to the application filed on 06/05/01. Claims 1-32 are pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-32 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-32 only recite an abstract idea. The recited steps of reporting a vehicle damage claim to an insurance provider by a claimant does not apply,

involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of returning the repaired claimant vehicle to the claimant.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces returning the repaired claimant vehicle to the insurer facility (i.e., repeatable) used in returning the repaired claimant vehicle to the claimant (i.e., useful, and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-32 are deemed to be directed to non-statutory subject matter.

In order for a claim to be statutory, the claimed invention must produce a useful, concrete, and tangible result and having "a computer system" or "a computer-medium" tied with the body of the claim in performing the recited steps.

As such, claims 1-32 do not recite any application or use of the technological arts, and thus equally rejected under 35 U.S.C.101.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi et al (5,950,169) in view of (PR Newswire; New York; Mark 21, 2001).

(A) As per claim 1, Borghesi discloses a method of processing vehicle damage claims, comprising the steps of:

reporting a vehicle damage claim to an insurance provider by a claimant (See Borghesi, Col.1, lines 29-55);

delivering a damaged claimant vehicle to an insurer facility operated by the insurance provider (See Borghesi, Col.5, lines 26-50);

preparing a repair estimate at the insurer facility by a representative of the insurance provider (See Borghesi, Col.7, lines 54-67);

selecting a repair facility, with the repair facility selected by the insurance provider (See Borghesi, Col.9, lines 18-42);

repairing the damaged claimant vehicle at the repair facility (See Borghesi, Col.4, lines 20-46).

Borghesi does not explicitly disclose that the method having returning the repaired claimant vehicle to the insurer facility; and returning the repaired claimant vehicle to the claimant.

However, these features are known in the art, as evidenced by PR Newswire. In particular, PR Newswire suggests returning the repaired claimant vehicle to the insurer facility; and returning the repaired claimant vehicle to the claimant (See PR Newswire, Page 2, Paragraphs 4-7).

It would have been obvious to one ordinary skill in the art at the time of the invention to have included the features of PR Newswire within the system of Borghesi with the motivation of providing a repair facility-locator service (See PR Newswire, Page 1, Paragraph 2).

(B) As per claim 2, Borghesi discloses the method further comprising the step of verifying insurance coverage after the step of reporting the vehicle damage claim to the insurance provider by the claimant (See Borghesi, Col.9, lines 18-42).

(C) As per claim 3, Borghesi discloses the method further comprising the step of scheduling with the claimant to deliver the damaged claimant vehicle to the insurer facility (See Borghesi, Col.9, lines 43-50).

(D) As per claim 4, Borghesi discloses the method wherein if the damaged claimant vehicle is not driveable the method further comprising the step of towing the damaged claimant vehicle to the insurer facility (See Borghesi, Col.17, lines 1-29).

(E) As per claim 5, Borghesi discloses the method further comprising the step of the insurance provider providing a rental vehicle to the claimant at the insurer facility (See Borghesi, Col.15, lines 64-67 to Col.16, line 22).

(F) As per claim 6, Borghesi discloses the method further comprising the step of the

insurance provider delivering a rental vehicle to the claimant and picking up the damaged vehicle at a location selected by the claimant (See Borghesi, Col.18, lines 7-40).

(G) As per claim 7, Borghesi discloses the method wherein the step of preparing the repair estimate at the insurer facility by the representative of the insurance provider includes at least partial dismantling of the damaged claimant vehicle for accurately assessing vehicle damage (See Borghesi, Col.18, lines 1-31).

(H) As per claim 8, Borghesi discloses the method wherein the repair facility selection step is based on one or more of repair facility capacity, experience, equipment, personnel, past performance, ability to begin repairs promptly, repair cycle time and scope of vehicle per repairs required (See Borghesi, Col.18, lines 7-40).

(I) As per claim 9, Borghesi discloses the method further comprising the step of the representative of the insurance provider at the insurer facility settling on an agreed price of vehicle repair with the repair facility (See Borghesi, Col.18, lines 41-51).

(J) As per claim 10, Borghesi discloses the method further comprising the step of the repair facility picking up the damaged claimant vehicle at the insurer facility, and returning the claimant vehicle to the insurer facility following completion of required repairs (See Borghesi, Col.18, lines 52-67 to Col.19, line 34).

(K) As per claim 11, Borghesi discloses the method further comprising the step of providing repair status updates to the claimant by the insurance provider (See Borghesi, Col.9, lines 18-41).

(L) As per claim 12, Borghesi discloses the method further comprising the step of the insurance provider inspecting and evaluating repair quality of the claimant vehicle at the insurer facility after the step of repairing the claimant vehicle at the repair facility (See Borghesi, Col.18, lines 7-51).

(M) As per claim 13, Borghesi discloses the method wherein the step of returning the repaired claimant vehicle to the claimant occurs at the insurer facility (See Borghesi, Col.17, lines 35-67).

(N) As per claim 14, Borghesi discloses the method wherein the claimant drops off the rental vehicle and picks up the repaired claimant vehicle at the insurer facility (See Borghesi, Col.18, lines 33-51).

(O) As per claim 15, Borghesi discloses a method of processing vehicle damage claims, comprising the steps of:

reporting a vehicle damage claim to an insurance provider by a claimant (See Borghesi, Col.1, lines 29-55);



delivering a damaged claimant vehicle to an insurer facility operated by the insurance provider (See Borghesi, Col.7, lines 54-67);

preparing a repair estimate at the insurer facility by a representative of the insurance provider (See Borghesi, Col.7, lines 54-67);

soliciting repair bids from repair facilities (See Borghesi, Col.18, lines 52-67 to Col.19, line 34);

selecting a repair facility, with the repair facility selected by the representative of the insurance provider at the insurer facility (See Borghesi, Col.9, lines 18-42).

repairing the damaged claimant vehicle at the repair facility (See Borghesi, Col.4, lines 20-46).

Borghesi does not explicitly disclose that the method having returning the claimant vehicle to the insurer facility; and returning the repaired claimant vehicle to the claimant.

However, these features are known in the art, as evidenced by PR Newswire. In particular, PR Newswire suggests that the method having returning the claimant vehicle to the insurer facility; and returning the repaired claimant vehicle to the claimant (See PR Newswire, Page 2, Paragraphs 4-7).

It would have been obvious to one ordinary skill in the art at the time of the invention to have included the features of PR Newswire within the system of Borghesi with the motivation of providing a repair facility-locator service (See PR Newswire, Page 1, Paragraph 2).

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(P) As per claim 26, Borghesi discloses a method of processing vehicle damage claims, comprising the steps of:

reporting a vehicle damage claim to an insurance provider by a claimant (See Borghesi, Col.1, lines 29-55);

delivering a damaged claimant vehicle to an insurer facility (See Borghesi, Col.5, lines 26-50);

providing a rental vehicle to the claimant at the insurer facility (See Borghesi, Col.18, lines 32-51);

preparing a repair estimate at the insurer facility by a representative of the insurance provider (See Borghesi, Col.16, lines 42-67);

electronically posting images of the damaged claimant vehicle and description of vehicle repairs required and soliciting repair bids from repair facilities where the posting is performed by the insurance provider (See Borghesi, Col.18, lines 52-67 to Col.19, line 39);

selecting a repair facility, with the repair facility selected by the insurance provider (See Borghesi, Col.9, lines 18-42);

repairing the damaged claimant vehicle at the repair facility (See Borghesi, Col.4, lines 20-46);

evaluating repair quality of the claimant vehicle at the insurer facility (See Borghesi, Col.10, lines 6-45).

Borghesi does not explicitly disclose that the method having returning the claimant vehicle to the insurer facility; and returning the repaired claimant vehicle to the claimant at the insurer facility.

However, these features are known in the art, as evidenced by PR Newswire. In particular, PR Newswire suggests that the method having returning the claimant vehicle to the insurer facility; and returning the repaired claimant vehicle to the claimant at the insurer facility (See PR Newswire, Page 2, Paragraphs 4-7).

It would have been obvious to one ordinary skill in the art at the time of the invention to have included the features of PR Newswire within the system of Borghesi with the motivation of providing a repair facility-locator service (See PR Newswire, Page 1, Paragraph 2).

(Q) As per claim 32, Borghesi discloses a method of processing vehicle damage claims, comprising the steps of:

reporting a vehicle damage claim to a coordination entity by a customer (See Borghesi, Col.12, lines 14-36);

delivering a damaged customer vehicle to a coordination facility (See Borghesi, Col.12, lines 14-36);

providing a rental vehicle to the customer at the coordination facility (See Borghesi, Col.18, lines 32-51);

preparing a repair estimate at the coordination facility by the coordination entity (See Borghesi, Col.16, lines 42-67);

selecting a repair facility, with the repair facility selected by the coordination entity  
(See Borghesi, Col.9, lines 18-42);

repairing the damaged customer vehicle at the repair facility (See Borghesi,  
Col.4, lines 20-46);

returning the damaged customer vehicle to the coordination facility (See  
Borghesi, Col.4, lines 20-46).

Borghesi does not explicitly disclose that the method having returning the  
repaired customer vehicle to the customer at the coordination facility; and returning the  
rental vehicle by the customer at the coordination facility.

However, these features are known in the art, as evidenced by PR Newswire. In  
particular, PR Newswire suggests that the method having returning the repaired  
customer vehicle to the customer at the coordination facility; and returning the rental  
vehicle by the customer at the coordination facility (See PR Newswire, Page 2,  
Paragraphs 4-7).

It would have been obvious to one ordinary skill in the art at the time of the  
invention to have included the features of PR Newswire within the system of Borghesi  
with the motivation of providing a repair facility-locator service (See PR Newswire, Page  
1, Paragraph 2).

(R) Claims 16-25 and 27-31 recite the underlying process steps of the elements of  
claims 2-13, respectively. As the various elements of claims 2-13 and have been shown  
to be either disclosed by or obvious in view of the collective teachings of X and Y, it is

apparent that the method disclosed by the applied art performs the recited underlying functions. As such, the limitations recited in claims 16-25 and 27-31 are rejected for the same reasons given above for method claims 2-13, and incorporated herein.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not the applied art teaches auto repair estimate, text and graphic system (5,432,904) and e Autoclaims.com Introduces the Next Generation in Web-Ware' Auto Claims Applications (PR Newswire. New York: Jul 19, 2000. pg 1).

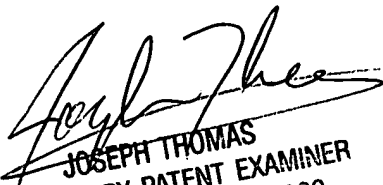
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V.F  
V.F

August 30, 2005

  
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